

REMARKS

The Office Action mailed December 11, 2006 has been carefully reviewed and considered. Claims 12-20 and 34-44 are previously pending and Claims 12-20 and 34-44 stand rejected. The Applicants have amended Claims 12, 18 and 34 and have cancelled Claims 41-44. Applicants reserve the right to pursue the cancelled claims in continuations, divisionals or for appeal purposes.

The 35 U.S.C. § 103 Rejection**Bailey in view of Evenson**

Claims 12, 16, 17, and 19 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bailey (US 5,800,179) in view of Evenson et al. (US 5,439,310). The Applicants respectfully traverse.

According to the Manual of Patent Examining Procedure (M.P.E.P.),

To establish a *prima facie* case of obviousness, three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in the applicant's disclosure.

M.P.E.P. 2141, See Hodosh v. Block Drug Co., Inc., 786 F.2d 1136 (Fed. Cir. 1986) (When applying a 35 U.S.C. 103 rejection, the following tenets of patent law must be adhered to: the claimed invention must be considered as a whole; the references must be considered as a whole

and must suggest the desirability and thus the obviousness of making the combination; the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and reasonable expectation of success is the standard with which obviousness is determined.)

In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 713 F.2d 1530 (Fed. Cir. 1983). Thus, when considering the whole prior art reference its entirety, portions that would lead away from the claimed invention must be considered. W.L. Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540 (Fed. Cir. 1983), See M.P.E.P. 2141.02. Thus, it is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731 (Fed. Cir. 1983).

Evenson describes a connector which has collet fingers 76 which snap into the socket extension 44 to engage the housing member 60 with housing 36. In particular, the collet fingers 76 expand to snap into the socket extension 44 when a force is applied by the actuating mechanism 32 in a longitudinal direction. However, one skilled in the art combining the teachings of Evenson with Bailey would still not reach each and every element/limitation of Claim 12 to establish a prima facie case of obviousness. Claim 12 recites, among other things, a capture mechanism configured to engage a peripheral device, the capture mechanism having a grasping member and an actuator, the actuator being configured to actuate the grasping member to close the grasping member around the peripheral device to engage the peripheral device therein in response to the peripheral device being inserted into the grasping member.

Evenson fails to teach that the collet expander receives a peripheral device and closes around the peripheral device to engage the peripheral device. Instead, Evenson teaches that force applied to member 32 causes the cone 80 to move downward and thus expand (and not close) the collet expander 76 in the socket extension 44. Additionally, Evenson does not disclose the mechanical means in its coupler for receiving an inserted device and engaging that device within the coupler. Thus, combining of Bailey with Evenson would not have a reasonable expectation of success since Evenson does not even receive a peripheral device therein. See Hodosh. Considering that Bailey and Evenson, individually or in combination, do not teach an actuator configured to actuate the grasping member to close the grasping member around the peripheral device to engage the peripheral device therein in response to the peripheral device being inserted into the grasping member, Claim 12 is non-obvious over in the cited combination. For at least these reasons, Claim 12 is allowable over Bailey in view of Evenson.

Claims 16, 17 and 19 are dependent on Claim 12. As stated above, Claim 12 is allowable over the cited references. Accordingly, Claims 16, 17 and 19 are allowable for being dependent on an allowable base claim.

Bailey in view of Evenson further in view of Sullivan

Claims 13-15, 18 and 20 were rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bailey (US 5,800,179) in view of Evenson et al. (US 5,439,310) and in further view of Sullivan et al. (US 5,745,753). The Applicants respectfully traverse.

Claims 13-15 and 20 are dependent on Claim 12. As stated above, Claim 12 is allowable over the cited references. Accordingly, Claims 13-15 and 20 are allowable for being dependent on an allowable base claim.

As stated above, one skilled in the art combining the teachings of Bailey, Evenson and Sullivan would still not reach each and every element/limitation of Claim 18 to establish a prima facie case of obviousness. Claim 18 recites, among other things, a capture mechanism configured to engage a peripheral device, the capture mechanism having a grasping member and an actuator, the actuator being configured to automatically actuate the grasping member to close the grasping member around the peripheral device to engage the peripheral device therein in response to the peripheral device being inserted into the grasping member.

Evenson fails to teach that the collet expander receives a peripheral device and closes around the peripheral device to engage the peripheral device. Instead, Evenson teaches that force applied to member 32 causes the cone 80 to move downward and thus expand (and not close) the collet expander 76 in the socket extension 44. Additionally, Evenson does not disclose the mechanical means in its coupler for receiving an inserted device and engaging that device within the coupler. Thus, combining of Bailey with Evenson would not have a reasonable expectation of success since Evenson does not even receive a peripheral device therein. See Hodosh. Considering that Bailey and Evenson, individually or in combination, do not teach an actuator configured to actuate the grasping member to close the grasping member around the peripheral device to engage the peripheral device therein in response to the peripheral device being inserted into the grasping member, Claim 18 is non-obvious over in the cited combination. For at least these reasons, Claim 18 is allowable over Bailey in view of Evenson.

Bailey in view of Randolph

Claims 34 is rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bailey (US 5,800,179) in view of Randolph (US 2,428,854). The Applicants respectfully traverse.

Randolph describes a click pen in which movement of the push button causes pen cartridge to protrude out of the pen housing or retract back into the pen housing. However, combining Bailey and Randolph does not reach each and every element/limitation of Claim 34.

Claim 34 recites, among other things, automatically engaging the peripheral device in a grasping member of the capture mechanism based on a first movement of the peripheral device, wherein the grasping member allows the peripheral device to be inserted therein and automatically closes around the peripheral device to engage the peripheral device from the first movement; and automatically releasing the peripheral device from the grasping member based on a second movement of the peripheral device, wherein the grasping member automatically opens in response to the second movement to allow the peripheral device to be released therefrom.

Neither Bailey, Randolph nor any of the other cited references provide the motivation to nor are successfully combinable to reach a grasping member which allows insertion of the peripheral device and automatically closes around the peripheral device to engage the device in response to a first movement. Further, none of references provide the motivation to nor are successfully combinable in disclosing the grasping member which automatically opens around the peripheral device to release the device in response to a second movement. For at least these

reasons, Claim 34 is patentable over Bailey and Randolph and is thus in a condition for allowance.

Bailey in view of Randolph and Sullivan

Claims 35, and 39-40 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bailey (US 5,800,179) in view of Randolph (US 2,428,854) and in further view of Sullivan at al. (US 5,746,753). The Applicants respectfully traverse.

Within the Office Action, it is stated that Sullivan teaches reducing the cross sectional dimension of the tubular member based on the movement of the spring as well as increasing the cross sectional dimension of the tubular member based on the movement of the spring. Applicants respectfully disagree and kindly request the Examiner to point to the specific portions of Sullivan that disclose these limitations.

Nonetheless, Claims 35 and 39-40 are dependent on Claim 34. As stated above, Claim 34 is allowable over the cited references. Accordingly, Claims 35 and 39-40 are allowable for being dependent on an allowable base claim.

Bailey in view of Randolph and Evenson

Claims 36-38 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bailey (US 5,800,179) in view of Randolph (US 2,428,854) and further in view of Evenson et al. (US 5,439,310). The Applicants respectfully traverse.

Claims 36-38 are dependent on Claim 34. As stated above, Claim 34 is allowable over the cited references. Accordingly, Claims 36-38 are allowable for being dependent on an allowable base claim.

Bailey in view of Muff

Claims 41 and 42 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sullivan at al. (US 5,746,753) in view of Muff (US 5,476,493). The Applicants respectfully traverse. However, to expedite prosecution of the present application, the Applicants have cancelled Claims 41 and 42 and reserve the right to pursue these claims in continuation/divisional applications as well as for appeal purposes. Accordingly, this rejection is now moot.

Bailey in view of Muff and Evenson

Claims 43 and 44 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Sullivan at al. (US 5,746,753) in view of Muff (US 5,476,493) and further in view of Evenson et al. (US 5,439,310). The Applicants respectfully traverse. However, to expedite prosecution of the present application, the Applicants have cancelled Claims 43 and 44 and reserve the right to pursue these claims in continuation/divisional applications as well as for appeal purposes. Accordingly, this rejection is now moot.

Conclusion

It is believed that this reply places the above-identified patent application into condition for allowance. Early favorable consideration of this reply is earnestly solicited.

If, in the opinion of the Examiner, an interview would expedite the prosecution of this application, the Examiner is invited to call the undersigned attorney at the number indicated below.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Please charge any additional required fee or credit any overpayment not otherwise paid or credited to our deposit account No. 50-1698.

Dated: 3/12/07

Respectfully submitted,

A handwritten signature in black ink, appearing to read "S. Blat", written over a horizontal line.

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